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Serial No.: 10/599,066
Docket No.: 1093-162 PCT/US/RCE II
Response to Non-Final Office Action Mailed August 10, 2011
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REMARKS

This submission is in response to the non-final Office Action mailed August 10, 2011. Claims 1-7, 11-16, 18 and 20-22 are currently pending in this application. By this response, Applicants have amended claims 1, 13 and 14, cancelled claim 11 and introduced new claim 23. The amendments to claim 1 and 14 clarify that the length expansion coefficients of the sealing layer and the film element are what do not differ by more than 10%, and/or alternatively the moduli of elasticity of the sealing layer and the film element are what do not differ by more than 10%. Thus, one or both corresponding aspects of the sealing layer and film element meet the 10% criterion. Claim 11 is hereby cancelled since this aspect is now substantially defined by claim 1. Also, the cancellation of claim 11 necessitated the change in dependency of claim 13. The amendment to claim 14 conforms to the similar amendments introduced here to claim 1. New claim 23 reintroduces the aspect of the security and/or valuable document defined by claim 1 as being a banknote, that that element has been removed from claim 1.

Accordingly, no new subject matter has been added by this response. Applicants respond specifically below to the issues raised in the subject Office Action and respectfully request reconsideration.

Interview Summary

Applicants thank Examiner Kyle Robert Brabowski for extending the courtesy of an in-person interview, which took place on October 27, 2011, during which meaningful and constructive dialogue was conducted to advance prosecution of the present application. Prior to

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the interview, a Pre-Interview Outline was provided to Examiner Brabowski, which included proposed amendments to claim 1 and explained why Applicants' disclosure satisfies the requirements of 35 U.S.C. §112, first paragraph. The Outline presented substantially the same arguments included below with regard to the §112, first paragraph rejection of the claims. The claim amendments presented during the interview substantially conformed to the claim amendments presented herein with some minor changes to further enhance the clarity thereof.

Additionally, during the interview Applicants' representative presented working specimens of the invention, as well as an example of a prior art representative banknote that does not employ the claimed features. As compared to the prior art representative banknote, the two specimens presented that employ applicant's disclosed technologies demonstrated a noticeable lack of waviness or cockling in the area of the film element.

During the interview, an agreement was reached that the amendment to the claims provided clarification regarding which aspects of the sealing layer and film element are being compared. Also, it was agreed that Applicants' original specification meets the enablement requirement overcoming the pending §112, second paragraph rejection. What is more, it was agreed that the claims would not be obvious over the cited prior art, alone or in combination.

Further, Applicants submit that the Substance of the Interview mailed November 2, 2011 accurately reflects the summary of what was discussed during the subject interview.

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Claim Rejections Under 35 U.S.C. §112, first paragraph

Claims 1-7, 11-16, 18 and 20-22 are rejected under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement. Applicants traverse this rejection.

Initially, it should be noted that the pending claims, as well as the amended claim 1 and 14 above, do not recite “specific length expansion coefficients or modulus of elasticity” for the claimed layered arrangement. Rather, the claims define that those aspects do not differ by more than 10% (or 5% in claims 12, 13). In particular, claim 1 recites “the sealing layer has a length expansion coefficient and/or a modulus of elasticity which differs from a respective length expansion coefficient and/or a modulus of elasticity of the film element by not more than 10%” (Emphasis added). Thus, it is only a difference that is defined between two very different elements likely composed of numerous constituent parts.

The purpose of the requirement that the specification describe the invention in such terms that one skilled in the art can make and use the claimed invention is to ensure that the invention is communicated to the interested public in a meaningful way. The information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention. Applicants respectfully note that the disclosure in the instant application, clearly meets this requirement. **MPEP 2164.01** (Test of Enablement) states: *As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied.* In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). This is notable, particularly since Applicants’ original disclosure not only included this very limitation, but it

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was recited in the original claims. Further, Applicants' disclosure gives a working example of the noted elements, particularly a Film Element (pages 10-11) and a Sealing Layer (pages 13-15), that comport with the claimed differential relationship.

The enablement requirement has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). Also, the fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), aff'd. sub nom., *Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). In accordance with MPEP 2164.04, "A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph".

Accordingly, respectfully request reconsideration and withdrawal of the rejection of claims 1-7, 11-16, 18 and 20-22 under 35 U.S.C. §112, first paragraph.

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Claim Rejections Under 35 U.S.C. §112, second paragraph

Claims 1-7, 11-16, 18 and 20-22 are rejected under 35 U.S.C. §112, second paragraph as being indefinite. Applicants traverse this rejection. In view of the amendments presented herein and the agreement reached during the above-noted interview, this rejection has been rendered moot. Accordingly, Applicants respectfully request withdrawal of this rejection.

Claim Rejections Under 35 U.S.C. §103

Claims 1-7, 11-16, 18 and 20-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over European Patent No. 1,398,174 to **Moreau** in view of U.S. Published Patent Application 2005/0040641 to **Cote** et al. In view of the agreement reached during the above-noted interview, this rejection has been rendered moot. Accordingly, Applicants respectfully request withdrawal of this rejection.

Conclusion

Applicants submit that the amended claims, particularly independent Claims 1 and 14 are patentable over the prior art. What is more, dependent Claims 2-7, 12, 13, 15, 16, 18 and 20-23, which ultimately depend from either Claims 1 and 14, are similarly patentable over the art of record by virtue of their dependence. Also, Applicants submit that Claims 2-7, 12, 13, 15, 16, 18 and 20-23 define patentable subject matter in their own right.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and allowance of the claims presented, particularly claims 1-7, 12-16, 18 and 20-

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23. If the Examiner has any questions or suggestions to expedite allowance of this application, he is cordially invited to contact Applicants' attorney at the telephone number provided.

Respectfully submitted,

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